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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,219	03/30/2004	Tatsuhito Mutoh	O11.2-11521-US01	3864

490 7590 10/10/2006

VIDAS, ARRETT & STEINKRAUS, P.A.  
6109 BLUE CIRCLE DRIVE  
SUITE 2000  
MINNETONKA, MN 55343-9185

EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/813,219

Applicant(s)

MUTOH ET AL.

Examiner

Michael A. Marcheschi

Art Unit

1755

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 20 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 112 first paragraph rejection of claim 21.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1-3, 5-18, 20 and 21.  
Claim(s) withdrawn from consideration: \_\_\_\_\_

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

  
Michael A. Marcheschi  
Primary Examiner  
Art Unit: 1755

## ATTACHMENT TO ADVISORY ACTION

Applicants argue that the GB reference does not teach a reaction product formed from the claimed materials. Applicants appear to be relying on process limitations (how the product is formed (i.e. by reaction between the specified components) and as is well established, process limitations used to define the product in "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964. In addition, it is the examiners position that either (1) the copolymer or (2) the alkyl ether reads on the material used, irrespective of how it was made or the reaction used to produce it. The arguments presented by applicants have not clearly shown otherwise because (1) it is admitted that the claimed reaction is a polyoxyethylene polyoxypropylene alkyl ether and (2) the reference uses an alkyl group (i.e. methyl, ethyl) and this is at least one of the claimed alkyl groups.

Applicants also argue the number of carbon atoms in the compound, however, this argument not persuasive because is not based on the total number of carbon atoms in the reaction product. In addition, the claims does not define the number of carbon atoms in the reaction product, thus applicants are arguing limitations not claimed (the features upon which applicant relies are not recited in the rejected claims). Applicants arguments provide no clear evidence that the claimed final material is distinct from the material used in the prior art. A mere statement without supporting facts (comparisons) is insufficient to establish patentability. Finally, the reference reaction product, as can be seen the description on page 10, line 1-page 11, line 27, is a reaction of polyalkylene oxide (oxides alone or copolymers thereof) and ethylene glycol. Column 10, lines 25-26 states that mixtures of the recited copolymers.

Applicants argue that Orii et al. discloses two different polishing compositions, the first composition contains a polyol (claimed material) and the second composition contains an organic salt (broadly reads on the salt of claim 1). It is apparently argued that none of the compositions contain both of the components above. As previously defined (the claimed combination), the reference states that the acid salt is added with a polymeric compound (see column 5, lines 5-6) and it is the examiners position that one skilled in the art would have appreciated that the polymeric compounds includes the polyols of the reference, thus the reference, as a whole, reads on the claimed combination. Applicants argue that the “polymeric compounds” are only limited to the materials defined in column 8, line 9 to column 9, line 36 and since these are not the claimed reaction products, the reference does not teach the claimed invention. The examiner disagrees with applicants characterization of column 8, line 9 to column 9, line 36. These paragraphs define (1) the polymeric surface modifier and (2) the surfactant, but not the polymeric compound. The second composition, above, contains in addition the acid salt, at least one of a surfactant, a surface modifier and a polymeric compound. The passage relied on by applicants defines the first 2 components of the Markush group and the examiner is unclear as to how this would establish that these components are the only materials within the interpretation of a “polymeric compound”, especially since the reference does not define that the polymeric compound is these materials. Applicants provide no clear and convincing evidence that the “polymeric compound” is only limited to the materials defined in column 8, line 9 to column 9, line 36 of the reference. In view of this, the examiners obviousness determination is still proper.